

20. (Amended) A computer-implemented method for selecting securities from a group of available securities for an investment portfolio, said computer performing the steps comprising:

calculating one or more characteristics of price appreciation for each of said available securities;

calculating a return on assets ratio for each of said available securities;

calculating a price to cashflow ratio for each of said available securities;

ranking at least some of the available securities according to predetermined criteria comprising a predetermined relationship between said one or more characteristics of price appreciation, said return on assets ratio and said price to cashflow ratio to form a group of ranked securities; and

selecting at least some of the ranked securities to form a group of selected securities.

40. (Amended) A computer-readable medium bearing a computer program containing instruction steps such that upon installation of said computer program in a general purpose computer, the computer performs the method of claim 20.

REMARKS

The applicants gratefully acknowledge the notice of allowance.

The applicants have not received the PTO-1449 forms signed by the Examiner that were submitted with three separate information disclosure statements mailed on the following dates: April 6, 2000; November 20, 2000; and March 5, 2001. The applicants respectfully request the Examiner to consider the references cited in the

information disclosure statements, sign the PTO-1449 forms submitted with the information disclosure statements and return the signed forms to the undersigned.

Responding to paragraph 1 of the Examiner's Amendment, there appears to have been a minor misunderstanding regarding claim 20. In this Amendment B, claim 20 has been amended to include the word "comprising," which was omitted in the Examiner's Amendment. The inclusion of the word "comprising" is necessary to insure that claim 20 is construed so that it does not exclude the presence of factors in addition to those explicitly recited. *Vivid Technologies, Inc. v. American Science & Engineering*, 200 F.3d 795, 811 (Fed. Cir. 1999).

Further responding to paragraph 1 of the Examiner's Amendment, there also appears to have been a minor misunderstanding regarding claim 40. In this Amendment B, claim 40 has been amended as in the Examiner's Amendment, except that the phrase "such that upon installation of" has been retained in the claim, and the word "performs" has been substituted for the word "performing." The Examiner deleted the phrase "such that upon installation of" and substituted the phrase "when installing." The phrase "when installing" might be misconstrued to mean that the instructions are used to enable the installation process. The instructions referred to in claim 40 are those that enable the computer to perform the method of claim 20. This meaning is made clear by retaining the original language "such that upon installation of ." Regarding the word "performing," the word "performs" has been substituted to improve the grammar of the claim.

For all the foregoing reasons, the applicants respectfully request that claims 20 and 40 as amended in this Amendment B be allowed by the Examiner.

Responding to the Statement Of Reasons For Allowance in paragraph 1 of the Allowance section of the Notice of Allowability, please consider the following comments:

Regarding the reasons for allowance, MPEP 1302.14 states:

The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth.

Since the Reasons for Allowance do not state all the reasons for allowance, the applicants object to the reasons to the extent that they impliedly state that all the reasons for allowance are set forth.

To the extent that the Reasons for Allowance suggest or state that certain limitations or combinations not found in the prior art are present in various claims whether or not specific language to the effect is found in such claims, the applicants note that the "record as a whole" must be considered as a supplement to the Examiner's stated Reasons for Allowance, and, to the extent that it is clear and complete, it shall control the interpretation of any and all claims.

For example, the Examiner states:

The prior art taken alone or in combination failed to teach or suggest "means for selecting securities from a group of available securities for an investment portfolio based on ..."

The applicants object to the underlined words, which do not appear in any claim, including claim 20. Regarding the word "means." The applicants do not intend the claims to be construed in accordance with 35 U.S.C. § 112, sixth paragraph, as means

plus function claims or step plus function claims. The use of the word "means" in the Reasons For Allowance might be misconstrued to erroneously imply such construction. The Reasons For Allowance use the term "based on" rather than --comprising--, which may lead to misinterpretation of the claims for the reasons stated in connection with the amendment to claim 20.

In summary, a confirmation of the allowance of claims 20-41 is respectfully requested.

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Respectfully submitted,


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ATTACHMENT MARKING CHANGES IN CLAIMS
Application No. 09/480,724, Filed January 7, 2000
Docket No. 12640US01

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calculating a price to cashflow ratio for each of said available securities;

ranking at least some of the available securities according to predetermined criteria comprising a predetermined relationship between said one or more characteristics of price appreciation, said return on assets ratio and said price to cashflow ratio to form a group of ranked securities; and

selecting at least some of the ranked securities to form a group of selected securities.

40. (Amended) A computer-readable medium bearing a computer program containing instruction steps such that upon installation of said computer program in a general purpose computer, the computer [is capable of performing] performs the method of claim 20.